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EXAMINER

JAIN, RAJ K

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/047,374
Filing Date: January 14, 2002
Appellant(s): MIGIMATSU, TAKA

Stephen W. Melvin
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 10, 2010 appealing from the Office action mailed February 11, 2009.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

1, 2, 4, 5, 31, 38, 45, 50, 53-55, 57,58 and 62-70.

(4) Status of Amendments After Final

Applicants amendments to claims 4 and 69 per Examiners suggestions are entered April 14, 2010 and on the record.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

5,608,786

GORDON

3-1997

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims recite here in part ".....wherein said digital message comprises a complete caller communication...". The specification and/or drawings fail to disclose what constitutes a "a complete caller communication", its not clear or understood whether complete caller communication is simply a telephone number used for paging, a brief message, a personal or subscriber ID, etc.. Clarification is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1, 2, 4, 5, 31,38,45,50,53-55,57,58 and 62-70 are rejected under 35 U.S.C. 102(e) as being anticipated by Gordon (USP 5,608,786).

Regarding claims 1, 4, 34, 40 and 43, Gordon discloses a system (Fig. 1) for transmitting and receiving voice messages from a caller 14, 16 over a network (PSTN and internet) (10, 4) said system comprising:

a first access device 6 (Fig.1), coupled to a network 10 said first access device 6 comprising a voice encoding device (Access device 6 has encoding device to convert communications received from one form to another as appropriate col 4 lines 63-65; col 5 lines 8-10,) configured to receive a first voice signal and generate digital message file (Fig. 1, each Unipost Access node converts incoming voice signal to a message file, col 5 lines 35-50; col 9 lines 5-9.), wherein said digital message file comprises a complete caller communication;

a first storage device capable of storing said digital message file (messages are stored for later retrieval; col 2 lines 8-15; 32-35; col 3 lines 35-45; col 6 lines 34-40.); a transmission device for transmission of said digital message file through said network 4

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(Figs 1 & 2, the unipost access nodes 6 includes transmission and receiving functional devices for transmission, reception and/or storage of digital data that can be retrieved by subscribers as needed, col 3 lines 30-50; col 4 lines 45-60; col 9 lines 12-16); wherein said transmission device transmits said digital message file through said network after said voice encoding device completes the generation of said digital message file, and wherein said transmission of said digital message file is responsive to a caller indication (col 2 lines 55-65; col 5 lines 17-31; 50-60; col 9 lines 35-60; a caller may initiate access to the unipost node based on a alert that a message is waiting to be retrieved at which point the access node will deliver the message to the subscriber);

a second access device 6 (Tokyo Unipost Access node) coupled to said network 4, said second access device 6 comprising: a receiving device configured to receive said digital message file from said transmission device (Figs 1 & 2, the unipost access nodes 6 includes transmission and receiving functional devices for transmission, reception and/or storage of digital data that can be retrieved by subscribers as needed, col 3 lines 30-50; col 4 lines 45-60; col 9 lines 12-16, furthermore, one skilled in the art will appreciate that Unipost Access Nodes anywhere geographically maintain similar functional devices such as transmitter, receiver and storage devices as necessary), responsive to said caller indication (col 2 lines 55-65; col 5 lines 17-31; 50-60; col 9 lines 35-60; a caller may initiate access to the unipost node based on a alert that a message is waiting to be retrieved at which point the access node will deliver the message to the subscriber);

a second storage device capable of storing said digital message file (messages are stored for later retrieval; col 2 lines 8-15; 32-35; col 3 lines 35-45; col 6 lines 34-40.);

a delivery notification device configured to notify of the receipt of said digital message file, said delivery notification device being responsive to said caller indication (col 2 lines 55-65; col 5 lines 17-31; 50-60; col 9 lines 35-60; a caller may initiate access to the unipost node based on a alert that a message is waiting to be retrieved at which point the access node will deliver the message to the subscriber); and

a voice decoding device configured to decode said digital message file and generate a second voice signal, wherein said voice decoding device decodes said digital message file after said receiving device completes the reception of said digital message file (col 4 line 55 - col 5 line 10; a digital message (entire message) left in the Unipost access node can be retrieved by a subscriber at a later time, further the message can be converted from one form to another (i.e. facsimile to email, email to speech), thus the process of decoding would be inherent in order to transform the message from one format to another and be properly retrieved and comprehended by a subscriber.).

Regarding claims 2, Gordon discloses a packet switched network (Fig. 1, ref. 4).

Regarding claims 5, Gordon discloses transmitting a voice signal from a caller (Fig. 1) voice device 16 through a caller communication medium (telephone line via PSTN 10) to said first access device 6 (see Fig. 1, voice device 16 connected via public switched telephone lines.).

Regarding claim(s) 38, 53 and 58, Gordon discloses a packet switched network 4 (Figs. 1-2).

Regarding claim(s) 63-65, Gordon discloses a caller/recipient voice device 16 (Fig. 1) and a caller/recipient telecommunication medium (telephone line to PSTN 10), wherein said caller/recipient voice device is coupled through said caller/recipient telecommunication medium to said voice encoding/decoding device (PSTN coupled to Unipost 6 which has the voice encoding/decoding device inherent within the system for message conversions col 4 line 55 - col 5 line 10).

Regarding claim(s) 31, 45, 50 and 66, Gordon discloses voice device as a telephone 16 (Fig. 1) and communication medium comprising a circuit switched network (PSTN 10).

Regarding claim(s) 54, 55, 57 and 62, Gordon discloses a circuit switched network as a PSTN (Fig. 1, ref. 10).

Regarding claims 67 and 69, Gordon discloses wherein destination information is received by said first access device before said transmission device transmits said digital message file (col 2 lines 1-15).

Regarding claims 68 and 70, Gordon discloses wherein said destination information is used to select said second access device (col 7 lines 18-55).

(10) Response to Argument

35 USC § 112 1st Paragraph Rejection

With respect to claims 1 & 4, Applicant contends the "newly added" subject matter in claims 1 & 4 is disclosed in the specification and fully enabled.

Examiner respectfully disagrees, the specification is “silent” (emphasis added) with respect to “complete caller communication”. With that said, it is not fully clear the intentions of the applicant as to how this is to be properly interpreted. The Examiner does not dispute the fact of the various implementation possibilities of the subject clause, rather the fact that the mere inclusion of “complete caller communication” without specifically identifying the "exact" nature of the clause within the specification Pre-Empts substantially all practical uses and thus limiting its applications by any other inventor, and therefore without specifically identifying the subject clause in the specification and its inventive concept, the Examiner asserts the claims 1 and 4 are rejectable under 35 USC 112 1st paragraph and therefore the rejection to claims 1 and 4 is sustained.

35 USC § 102(e) Rejection

With respect to claims 1, 2, 4, 5, 31,38,45,50,53-55,57,58 and 62-70 as being anticipated by Gordon (USP 5,608,786).

Applicant contends Gordon fails to disclose "transmission of voice messages over a network" rather “messages are confined to a central repository.

Examiner respectfully disagrees, Gordon explicitly discloses a call or messaging (emphasis added) being performed prior to transmission of the same by a subscribers request (see col 2 lines 8-15; 32-35; col 3 lines 35-45; col 6 lines 34-40, col 6 lines 59 – col 7 line 10 messages may be stored for later retrieval by a subscriber from any geographical location when appropriate.) A complete email, voice message, facsimile can stored in the Unipost access node (Fig. 1, ref 6) that can than be accessed by a

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subscriber from any location that has access to the Unipost node. Such messaging schemes regardless of their storage location when being accessed by a subscriber require the transmission of said message “over a network” for the subscriber to review and/or respond accordingly.

Applicant further contends that Gordon fails to disclose “transmission of voice messages responsive to the sender of the message”.

Examiner respectfully disagrees, Gordon explicitly discloses a message awaiting receipt by a subscriber by notifying the subscriber via an alert signaling which may then be transmitted automatically to the subscriber or upon request by the subscriber (col 2 lines 55-65; col 5 lines 17-31; 50-60; col 9 lines 35-60; a caller may initiate access to the unipost node based on a alert that a message is waiting to be retrieved at which point the access node will deliver the message to the subscriber).

Applicant further contends “Messages are not “pushed” over a network based on the actions of the caller, or the sender of the message.

This contention is moot, as the subject claims fail to require any messaging being “pushed” over the network.

Thus based on the foregoing reasoning, Examiner asserts that all limitations are disclosed and/or taught by Gordon and therefore the rejection to claim 1 is sustained.

Further regarding the rejection to claim 4 which recites features similar to claim 1 is also sustained for same reasoning as to claim 1. However for clarity, Examiner

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addresses Applicants specific contention of Gordon failing to disclose comprising "a complete caller communication".

Examiner respectfully disagrees, Gordon explicitly discloses that a complete call (emphasis added) or messaging is performed prior to transmission of the same by a subscribers request (see col 2 lines 8-15; 32-35; col 3 lines 35-45; col 6 lines 34-40, col 6 lines 59 – col 7 line 10 messages may be stored for later retrieval by a subscriber from any geographical location when appropriate.) A complete email, voice message, facsimile can stored in the Unipost access node (Fig. 1, ref 6) that can than be accessed by a subscriber from any location that has access to the Unipost node.

Regarding claims 68 and 70, Applicant contends "Gordon does not disclose the use of destination information to select the destination of a voice message prior to transmission of that voice message."

Examiner respectfully disagrees, Gordon explicitly and clearly illustrates that in order for a message to be delivered to a subscriber who for example "travels" and is quite often distant from their unipost access node, a specific address such as a MAC address (i.e. Destination information) is used to identify the location of the subscriber to properly deliver the message (Fig. 3, col 7 lines 18-34). Furthermore, if no addressing were available, than how is a packet or message being delivered to specific subscriber, thus mobile IP allows for IP addressing specific to the subscriber anywhere they may connect to the internet. Thus based on the foregoing, Examiner asserts Gordon discloses destination information for transmission of voice messages to the specific subscriber and therefore the rejection to claims 69 and 70 is sustained.

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Furthermore, rejection to dependent claims 2, 5, 31,38,45,50,53-55,57,58 and 62-70 is sustained based on limitations being met by cited prior art(s).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/RAJ JAIN/

Examiner, Art Unit 2472

Conferees:

/William Trost/

Supervisory Patent Examiner, Art Unit 2472

/DANG T TON/

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